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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,846	09/22/2003	John J. Disco JR.	P-2469	1372

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EXAMINER

O CONNOR, CARY E

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/667,846

Applicant(s)

DISCKO

Examiner

Cary E. O'Connor

Art Unit

3732

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-40 is/are allowed.
- 6) ☒ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6, 7, 9-11, 15, 16, 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Spector (4,671,306). Spector shows a material dispenser comprising a block of pliable material 14 and an opening (slit) 15 formed in the pliable material. The dispenser is capable of holding a material to be dispensed. As to claim 3, the longitudinal dimension of the slit cannot be given patentable weight in the claim because it is based on an element (the applicator) which is not positively claimed. As to claims 6 and 16, note that the pliable material may comprise foam (column 2, line 56). As to claims 7 and 20, note the material placed in the pliable material (column 2, lines 59-62). As to claims 9 and 18, note the impervious material 10 placed around the pliable material. As to claims 10 and 19, the foam material inherently blocks actinic light. As to claim 11, note that Spector discloses that the pliable material fits snugly in the cup (column 2, lines 54-55). Accordingly, friction is considered a means for holding the pliable material in position. As to claim 15 and the recitation that the dispenser is "for dispensing a low viscosity material used in a dental procedure", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963)

Claims 1, 4-12, 15-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Riitano (5,967,778). Riitano shows a material dispenser comprising a block of pliable material 18 and an opening inherently formed in the pliable material due to the material's porous characteristics. The dispenser is capable of holding a material to be dispensed. As to claim 5, note that the figures show the block of pliable material having six sides. As to claim 6 and 16, note that the pliable material may comprise foam (column 6, lines 40-44). As to claims 7, 8, 20 and 21, note that a disinfecting solution 24 may be placed in the pliable material (column 5, line 29). As to claims 9 and 18, note the impervious material 16 placed around the pliable material. As to claims 10 and 19, the foam material inherently blocks actinic light. As to claims 11, 12 and 17, note that the pliable material is held in the container 16 by an adhesive (column 11, lines 16-17).

Claims 1, 4-6, 9-13, 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Conard et al (4,936,449). Conard shows a material dispenser comprising a block of pliable material 20 and an opening inherently formed in the pliable material due to the material's porous characteristics. The dispenser is capable of holding a material to be dispensed. As to claim 5, note that the figures show the block of pliable material having six sides. As to claims 6 and 16, note that the pliable material may

comprise foam (column 4, line 1-3). As to claims 9 and 18, note the impervious material 30 that may be placed around the pliable material. As to claims 10 and 19, the foam material inherently blocks actinic light. As to claims 11-13 and 17, note that the pliable material may be held in place by a pressure sensitive adhesive 22 and a protective backing 24 covers the adhesive. As to claim 15 and the recitation that the dispenser is "for dispensing a low viscosity material used in a dental procedure", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claims 1, 4-6, 9-11, 14-16, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnsen et al (6,036,490). Johnsen shows a material dispenser comprising a block of pliable material 14 and an opening inherently formed in the pliable material due to the material's porous characteristics. As to the intended use recitation, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the

prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). As to claim 5, note that the block has at least six planar sides. As to claims 6 and 16, note that the pliable material may comprise a sponge-like material (column 4, line 10-16). As to claims 9 and 18, note the impervious material 12 placed around the pliable material. As to claims 10 and 19, the sponge-like material inherently blocks actinic light. As to claims 11 and 14, note the ring 18 for holding the pliable material in position.

Claims 25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Hesselgren (4,232,784). Hesselgren shows a material dispenser comprising a block of pliable material 1 having six sides and a slit formed in the block of pliable material. The dispenser is capable of holding a material (column 2, lines 64-66) to be dispensed onto an applicator 4. The slit has a longitudinal dimension at least three times the lateral dimension of the applicator end. As to the intended use recitation, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). As to claim 27, note the impervious material 1 placed on five of the six sides of the block of pliable material.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conard et al (4,936,449) in view of Spector (4,671,306). Conard shows a material dispenser comprising a block of pliable material 20 and an opening inherently formed in the pliable material due to the material's porous characteristics. The dispenser is capable of holding a material to be dispensed. the pliable material may be held in place by a pressure sensitive adhesive 22 and a protective backing 24 covers the adhesive. Conard does not employ a slit as the opening in the pliable material. Spector shows a material dispenser comprising a block of pliable material 14 and an opening (slit) 15 formed in the pliable material. It would have been obvious to form a slit or slits in the block of pliable material of Conard, in view of Spector, in order to aid insertion of the instruments in the block. As to claims 23 and 27, note that the block of Conard may be covered on five of the six sides by an impervious material 88. As to claims 24 and 28, note that a disinfectant may be placed in the block of Conard.

***Allowable Subject Matter***

Claims 29-40 are allowed.

***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 703-308-2701. The examiner can normally be reached on M-Th 7:00-3:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Cary E. O'Connor  
Primary Examiner  
Art Unit 3732

ceo  
September 3, 2004